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FOLEY & LARDNER 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,081

Applicant(s)

MOYER, MIKE

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/3/2004 has been entered.

Response to Amendment

2. The applicant's amendment received on September 2, 2004 is acknowledged and entered. The applicant has amended claims 1, 2, 11-20 and 30 are amended. Currently claims 1-30 are pending for examination.

Response to Arguments

3.1. Applicant's arguments, see remarks, page 8, filed on September 02, 2004 concerning rejection of claims 11-19 and 30 under 35 U.S.C. 101 have been fully considered and they are persuasive in view of the amendments made to claims 11-20 and 30. Accordingly, rejection of claims 11-19 and 30 under 35 U.S.C. 101 is withdrawn.

3.2. Applicant's arguments, see remarks pages 8-11, filed on September 02, 2004 concerning claims 1-30 have been fully considered but they are moot in view of new grounds of rejection necessitated due to amendment to claims 1, 11 and 20.

This is non-final Office action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 1, 3-10, 11, 13-20, and 22- 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schachne and further in view of Henson (US Patent 6,167,383).

Regarding claim 1, Schachne teaches a computer-implemented method for conducting business over a network utilizing a graphical user interface (see at least abstract, and page 1, paragraphs 0005-0006), comprising the steps of:

(a) receiving a request indicating a primary product or service utilizing a network (see at least FIG.3, " **72—Request Product Info From Computer Site**", and page 2, paragraphs 0018-0019 , " **FIG.3 shows a flow chart To initiate a business transaction over the network 18, the customer using the computer system 10 requests access to a web page of the seller stored on the server system 14 (step 72). In response to this request, the server system 14 transmits the requested web page to the computer system 10 (step 74).....**" . Note: In Schachne the step 72 of requesting product information via network 18 corresponds to the claimed limitation. "The product" is Schachne corresponds to a primary product/service.).

(b) displaying the primary product or service on a graphical user interface utilizing the network in response the request (see at least FIG.2, " 56" is the graphical image of a business offering. Note: "business offering" in Schachne corresponds to the primary product/service as claimed. Further, to display graphical image "56" a product/service

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will inherently include a graphical user interface. Further, see page 2, paragraph 0016, "*.....The order form can also include instructions 50 on filling out the form, a description 52 of each business offering being ordered, and a graphical image 56 of that business offering.* ". Also see page 1, paragraph 0012 "*..Each Web page provides a graphical representation of text and images...").* ;

(c) displaying at least one secondary product or service associated with the primary product or service utilizing the network (see at least FIG.3, " 84—*Make An Offer To The Customer To Conduct A Second Different Transaction* ", page 1, paragraph 005, page 2, paragraph 0022-page 3, paragraph 0024, " *..... an offer is presented to the customer to enter a second business transaction different from the previous business transaction (step 84). The offer can be presented by a pop-up window on the screen 30 of the computer system 10 or by a new display screen.[0023] Presenting this offer at the moment the customer intends to conclude the previous business transaction generates one more opportunity for the seller to gain a sale from the customer..... In one embodiment, the offer can involve subject matter that is related to subject matter of the previous business transaction..... FIG. 4 shows an exemplary pop-up window 114 containing the offer 116 superimposed on the order form 48.* ". Note: In Schachne, the displaying of second business transaction related to the first business transaction corresponds to displaying one secondary product or service associated with the primary product/service. The above segments clearly suggests that the offering of second item is presented to the user on knowing his intention to conclude the business transaction for the first item but **not** after the conclusion of business transaction for the first item. This limitation is further suggested in Schachne when he suggests that the offering for second item is made at the time of the user acquiring the order form 48 to fill in details for the purchase of the first item.).; and

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(d) allowing a user to select the at least one secondary product or service utilizing the network (see at least FIG.4, " 118-Accept, 122-Reject " and page 3, paragraph 0024, "*..FIG. 4 shows an exemplary pop-up window 114 containing the offer 116 superimposed on the order form 48. The offer 116 can include a graphical button 118 for accepting the offer and another graphical button 122 for rejecting the offer. In another embodiment, the offer 116 can be displayed on a new screen display.*" . Note: In Schachne, the step of allowing the user to accept an offer 116, which can be either that is primary or secondary, corresponds to allowing a user to select at least one secondary product or service as claimed. Also see page 3, paragraph 0025, which is directed to the concluding of secondary product/service).

Schachne does not explicitly disclose displaying at least one secondary product or service associated with the primary product or service utilizing he network prior to providing a purchase order for the primary product or service. However, Henson in the same field of endeavor teaches displaying at least one secondary product or service associated with the primary product or service utilizing he network prior to providing a purchase order for the primary product or service (see at least Figs. 3 A, 3 B, 4 and 5 which display the primary item as main computer system, such as Dell Dimension XPS R and the system also displays at least one secondary product/service in the form of Monitor, Speakers, Software, Accessories" before providing a purchase order. Also, see col.6, lines 18-30, wherein the displayed options correspond to secondary products. In view of Henson, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Schachne to incorporate the feature of displaying at least one secondary product or service associated with the primary product or service utilizing he network prior to providing a purchase order for

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the primary product or service because as explicitly suggested in Schachne (see paragraph 005 on page 1) it enables the user to place orders for more items related/associated to primary item without having to submit additional personal and payment information again and again and thereby making the operation simple and efficient and also for the reasons disclosed in Henson (see col.col.6, lines 18-30 to enable the customize the primary item with options and accessories per his choice.

Regarding claim 3, Schachne in view of Henson teaches a computer-implemented method offering a secondary product/service to a user over a network, as analyzed and disclosed in claim 1 above. Schachne further comprises providing a check out icon on the graphical user interface, wherein selecting the check out icon produces a check out interface that lists the primary product or service and any secondary product or service selected by the user for purchase (see at least page 3, paragraphs 0024-0026, "*.....The offer 116 can include a graphical button 118 for accepting the offer In another embodiment, the offer 116 can be displayed on a new screen display. [0025] Referring again to FIG. 3, when the customer accepts the offer, this concludes the second business transaction without requiring the customer to submit additional customer information or reply to any queries or make any other selections or responses (step 88). [0026] Because this process requires no further action from the customer to complete the proposed second business transaction, the relative ease of conducting business transactions may entice the customer to accept the offer, and consequently stimulates business.*" . Note: In Schachne, "a graphical button 118 for accepting the offer" corresponds to the check out button as claimed. By selection of this button the system links to the check out interface so that the process requires no further

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action from the customer to complete the purchase transaction for both primary and secondary products/services selected by the consumer.).

Regarding claim 4, Schachne in view of Henson teaches a computer-implemented method offering a secondary product/service to a user over a network, as analyzed and disclosed in claim 1 above. Schachne further discloses the step of providing an add icon on the graphical user interface, wherein selecting the add icon adds the primary product or service and any secondary product or service selected by the user to an electronic shopping basket (see at least page 3, paragraphs 0024-0026, *".....The offer 116 can include a graphical button 118 for accepting the offer In another embodiment, the offer 116 can be displayed on a new screen display. [0025] Referring again to FIG. 3, when the customer accepts the offer, this concludes the second business transaction without requiring the customer to submit additional customer information or reply to any queries or make any other selections or responses (step 88). [0026] Because this process requires no further action from the customer to complete the proposed second business transaction, the relative ease of conducting business transactions may entice the customer to accept the offer, and consequently stimulates business. "* Note: In Schachne, "a graphical button 118 for accepting the offer" corresponds to the add on button as claimed. By selection of this button the system inherently adds the items selected, which include both primary and secondary because after clicking this icon the process requires no further action from the customer to complete the purchase transaction for both primary and secondary products/services selected by the consumer.).

Regarding claim 5, Schachne in view of Henson teaches a computer-implemented method offering a secondary product/service to a user over a network, as analyzed and disclosed in claim 1 above. Schachne further discloses that the user

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selects the at least one secondary product or service by selecting a check box (see at least FIG.4, " 118-Accept, 122-Reject " and page 3, paragraph 0024, "*..FIG. 4 shows an exemplary pop-up window 114 containing the offer 116 superimposed on the order form 48. The offer 116 can include a graphical button 118 for accepting the offer and another graphical button 122 for rejecting the offer. In another embodiment, the offer 116 can be displayed on a new screen display.*" . Note: In Schachne, the step of allowing the user to accept a secondary offer 116 by pressing a graphical button 118 for accepting the offer corresponds to selecting a check box as claimed because in any case the box is to be clicked to indicate selection.).

Regarding claim 6, Schachne in view of Henson teaches a computer-implemented method offering a secondary product/service to a user over a network, as analyzed and disclosed above in claim 1. Schachne further discloses that the user deselects the at least one secondary product or service by selecting the check box again (see at least FIG.4, " 118-Accept, 122-Reject " and page 3, paragraph 0024, "*..FIG. 4 shows an exemplary pop-up window 114 containing the offer 116 superimposed on the order form 48. The offer 116 can include a graphical button 118 for accepting the offer and another graphical button 122 for rejecting the offer. In another embodiment, the offer 116 can be displayed on a new screen display.*" . Note: In Schachne, the step of allowing the user to reject a secondary offer 116 by pressing a graphical button 122 again for rejecting the offer corresponds to deselecting the offer 116 for secondary product/service).

Regarding claim 7, Schachne in view of Henson teaches a computer-implemented method offering a secondary product/service to a user over a network, as analyzed and disclosed in claim 1 above. Schachne further discloses the step of

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providing a link to an additional graphical user interface featuring the secondary product or service (see at least page 3, paragraph 0025, "*.....Referring again to FIG. 3, when the customer accepts the offer, this concludes the second business transaction If the offer originated from a server system other than the server system 14, then the computer system 10 can communicate the acceptance of the customer and the customer information with that other server system 16, directly or via the server system 14, and that other server system 16 can use the customer information to conclude the second business transaction.* ". Note: It was already analyzed above that the user indicates his acceptance of the offer for secondary products/services by selecting and clicking graphical button 122 in claim 5 above. Here, in paragraph 0025, Schachne discloses that the acceptance of the offer for the secondary product/service is communicated to another server system 16 via existing server system 14 corresponds to linking to an additional graphical user interface featuring the secondary products/services on the other server 16.).

Regarding claim 8, Schachne in view of Henson teaches a computer-implemented method offering and displaying a secondary product/service related to a primary product/service to a user over a network, as analyzed and disclosed in claim 1 above. Schachne, further, shows displaying a plurality of additional primary products or services on the graphical user interface (see at least page 2, paragraph 0015, "*In this embodiment, the web pages stored on the server system 14 include a plurality of web pages designed by a business association that advertise business offerings (e.g., products and services) of the business association. Some of these web pages are designed to conduct business transactions so that potential customers using remote computer systems, such as the computer system 10, can access these web pages, browse the business offerings, and submit purchase orders across the network 18. A business transaction includes taking by sale, lease, premium, gift, or any other voluntary transaction between a potential customer and a business*

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association that gives the customer an interest in a business offering of the business association.

" . Note: Here, Schachne discloses that the system offers a plurality of products/services for sale and therefore, keeping in view the teachings of claim 1, Schachne can display a plurality of additional primary products or services related to the primary products or services on the graphical user interface.).

Regarding claim 9, Schachne in view of Henson teaches a computer- implemented method offering and displaying a plurality of additional primary products or services related to the primary products or services on the graphical user interface as analyzed and disclosed in claim 8 above. Schachne further suggests providing a link to an additional graphical user interface featuring the additional primary products or services (see at least page 3, paragraphs 0024-0025, " *FIG. 4 shows an exemplary pop-up window 114 containing the offer 116 superimposed on the order form 48. The offer 116 can include a graphical button 118 for accepting the offer In another embodiment, the offer 116 can be displayed on a new screen display. [0025] Referring again to FIG. 3, when the customer accepts the offer..... The computer system 10 signals the server system 14 of the acceptance, and transmits the customer information, if not previously transmitted. If the offer originated from a server system other than the server system 14, then the computer system 10 can communicate the acceptance of the customer and the customer information with that other server system 16, directly or via the server system 14, and that other server system 16 can use the customer information to conclude the second business transaction.* " . Note: In Schachne, accepting the offer by clicking the graphical button 118 corresponds to selection of an icon indicative of the additional primary products/services and linking to another server system 16 via existing server system 14 corresponds to linking to an additional graphical user interface featuring the additional primary products or services. The secondary business transaction, in Schachne, relates to additional primary

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products/services , see at least paragraph page 3, paragraph 0023, *"In another embodiment, the subject matter of the offer can be unrelated to the subject matter of the previous business transaction. A different business association than the business association of the previous business transaction may be presenting the offer. "* When the offer for products/services is not related to the earlier product then the offer constitutes for additional primary products/services.).

Regarding claim 10, Schachne in view of Henson teaches a computer-implemented method offering and displaying a secondary product/service related to a primary product/service to a user over a network, as analyzed and disclosed in claim 1 above. Schachne, further, shows that the secondary product or service is intended to be used with the primary product or service (see at least page 3, paragraph 0023, *".....Presenting this offer at the moment the customer intends to conclude the previous business transaction generates one more opportunity for the seller to gain a sale from the customer, particularly if the offer brings to the attention of the customer an item of potential or known interest that may have been overlooked. In one embodiment, the offer can involve subject matter that is related to subject matter of the previous business transaction. For example, if the previous business transaction is a purchase of a certain book, then the second, different business transaction can be for the purchase of another book by the same author or on the same topic..... "*. Note: In Schachne, the previous business transaction corresponds to primary products/services and second, different business transaction corresponds to the secondary products/services related to the primary products/services. In the illustrated example Schachne, discloses that the secondary offer for a book is also related to the same topic as the previous book and thus the user using the previously purchased book will also use/consult/read the second book as it is related to the same

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topic.).

Regarding claim 11, all the intended functions of the computer program product code are directed to the same functions as recited in the steps of method claim 1.

Therefore, claim 11 is rejected as being unpatentable over Schachne in view of Henson on the basis of same rational as discussed for claim 1 above.

Regarding claims 13-19, and 30, all the intended functions of the computer program product codes are directed to the same functions as recited in the steps of method claims 3-10. Therefore, claims 13-19 and 30 are rejected as being unpatentable over Schachne in view of Henson on the basis of same rational as discussed for claims 3-10 above.

Regarding claim 20, all the intended functions of the system for conducting business over a network utilizing a graphical user interface are directed to the same functions as recited in the steps of method claim 1 except for reciting the use of a web server providing and displaying product information via web documents, which are accessible by the web server . The reference Schachne teaches the use of web server and providing and displaying product information via web documents, which are accessible by the web server (see at least page 1, paragraph 0012, "*The network 18 can be a large international network (e.g., the Internet or the **World Wide Web**) or a small local area network (LAN) that includes a plurality of other computer and server systems (i.e., web sites). Many web sites maintain information including text files, graphics files, and executable scripts (e.g., applets) that can be collectively stored as "Web pages." Each Web page provides a graphical representation of text and images designed by the designer of that Web page. Some of the other systems on the network 18 can be gateway computers (not*

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shown), maintained by an Internet service provider, e.g., Earthlink, which provides access to the information on the other web sites and, in particular, to the server system 14 "). Therefore, claim 20 is rejected as being unpatentable over Schachne in view of Henson on the basis of same rational as discussed for claim 1 above.

Regarding claims 22-29, their limitations are parallel to those of method claims 3-10. Therefore, claims 22-29 are rejected as being unpatentable over Schachne in view of Henson on the basis of same rational as discussed for claims 3-10 above

4.2. Claims 2, 12, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schachne in view of Henson and further in view of Sparks.

Regarding claim 2, Schachne in view of Henson teaches a computer-implemented method for offering and displaying primary and secondary products/services to a user over a network, as analyzed and disclosed in claim 1 above.

Schachne does not disclose comprising providing a shopping cart icon on the graphical user interface, wherein selecting the shopping cart icon produces a shopping cart interface that lists the primary product or service and any secondary product or service selected by the user for reviewing the selected product or service prior to purchase. However, in the field of same endeavor, that is electronic commerce, Sparks teaches comprising providing a shopping cart icon on the graphical user interface, wherein selecting the shopping cart icon produces a shopping cart interface that lists the primary product or service and any secondary product or service selected by the user for reviewing the selected products or services prior to purchase (see at least FIG.3, " 80-

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cart" and col.5, lines 48-49, " *..placing retrieved images in a " shopping cart" for purchase, by clicking on button 80* ". Note: In Sparks, clicking on button 80 corresponds to the step of linking to a shopping cart icon in response to the selection of a shopping cart icon on the graphical user interface as claimed. Further, placing the retrieved images in the " shopping cart" for purchase corresponds to listing the purchased products, both primary and secondary before purchase, as claimed.).

In view of Sparks, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Schachne in view of Henson to incorporate the concept of Sparks of listing the purchased items in the shopping cart by clicking a shopping cart icon because it was well-known at the time of the applicant's invention to use shopping cart while buying products/services on-line to hold/list the purchased items just the same way a consumer does physically when making purchases in a departmental store and holding a physical cart before making the final check-out so that a person could add or delete some of the listed items before making a payment.

Regarding claims 12 and 21, their limitations are parallel to those of method claim 2 and are rejected as being unpatentable over Schachne in view of Henson and further in view of Sparks on the basis of same rationale as discussed for claim 2 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Yogesh C Garg', written over a horizontal line.

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
January 10, 2005